

Appl. No. 09/974,853

Art Unit 1771

May 18, 2004

**Preliminary Reply Under 37 C.F.R. § 1.111 and
Submission with Request for Continued Examination
Under 37 C.F.R. § 1.114**

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the filed Request for Continued Examination under 37 C.F.R. § 1.114 and the foregoing remarks and changes to the claims.

In the present reply, the new issue of claim 14 has been added. Thus, claims 1, 3-11 and 14 are pending in the present application. No new matter has been added with new claim 14 since this claim is supported by original claims 1 and 8 and by the present specification at, for example, page 6, lines 4-10 and 24-25, page 7, lines 8-13 and 22-23, the paragraph bridging pages 10-11, and page 12, lines 1-6.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 1-13 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully refer the Examiner to the reply of November 25, 2003, which sufficiently addresses this rejection. Still, Applicants provide the following added remarks to address the new comments in the Advisory Action (at page 2, which is a continuation of box 5).

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As shown in the specification at page 3, lines 17-20 and page 4, line 22 to page 5, line 23, the term "static friction" is a parameter recognized in the cleaning sheet art as one of the characteristics of the instantly claimed product which particularly points out and distinctly claims what it is. One skilled in the art would also understand the scope of the JIS L3201 R33W standard. Further, the cleaning sheet and nonwoven fabric themselves are considered structure, which can be applied, e.g., to a tool as shown in Figure 2. If the Examiner's position is maintained, Applicants respectfully request a clearer basis (*i.e.*, relevant U.S. case law) as to why the present claim language does not meet the provisions of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 09-224895 ("JP '895") in view of JP 10-060761 ("JP '761") and JP 2000-328415 ("JP '415"). Reconsideration and withdrawal of this rejection is respectfully requested based upon the following considerations.

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First, Applicants respectfully submit that the comments in the previous reply of March 25, 2004 fully and adequately address this rejection. Thus, those comments are herein incorporated, and Applicants respectfully request consideration and withdrawal of this rejection.

Second, Applicants provide the following comments with respect to the new comments in the recent Advisory Action. As a continuation of 5, at page 2 of the Advisory Action, the Examiner refers Applicants to paragraph [0039] of JP '415 and asserts that JP '415 is from the same field of endeavor based on its international classification. Still, Applicants respectfully maintain their position that the cited references are not in an analogous art with one another.

Though the cited JP '415 reference may belong to the stated international classification, Applicants respectfully refer the Examiner to M.P.E.P. § 2141.01(a), wherein even a PTO classification is some evidence of analogy but it is not conclusive evidence. Instead, "similarities and differences in structure and function carry far greater weight" (citing *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) and *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992)). Applicants also respectfully refer the Examiner to *In re Clay*, wherein the Federal Circuit found that the inventions in the cited references involved different structures for different purposes under different temperature and pressure conditions, and disagreed with the PTO's argument that the reference and claim inventions were part of the

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same endeavor. Clay, 23 USPQ2d at 1061. Similarly, Applicants respectfully request reconsideration herein since JP '415 belongs to a different technical field from JP '895 and JP '761 since the JP '415 reference merely discloses an air-laid nonwoven fabric that is suitable for disposable diapers, etc., and used to absorb sweat and other liquids. Thus, similarities and differences in structure and function carry far greater weight than the classification of JP'415. Also, JP '415 is not within the same field of endeavor and is non-analogous to the other cited references and/or the present invention.

Therefore, Applicants respectfully submit that the cited references have been improperly combined and that the requisite motivation and reasonable expectation are so lacking that a *prima facie* case of obviousness has not been established. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Reconsideration and withdrawal of this rejection under § 103(a) are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

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Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #32,881
John W. Bailey, #32,881

JWB/ETP/las
0445-0310P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000